

December 2003

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Recommended Citation

Carson, Bryan M. J.D., M.I.L.S. (2003) "Dewey, Daster, and the OCLC-Library Hotel Dispute: A Question of Trademark or Copyright," *Against the Grain*: Vol. 15: Iss. 6, Article 24.

DOI: <https://doi.org/10.7771/2380-176X.4215>

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LEGAL ISSUES



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Dewey, Dastar, and the OCLC-Library Hotel Dispute: A Question of Trademark or Copyright

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This article will discuss the current legal dispute between the **Library Hotel** and **OCLC** over the phrase **Dewey Decimal System**. I will also give you a brief primer on trademark law, which I have not covered in this column before. The next section will trace the history of the **Dewey Decimal System**. I will discuss the trademark claims of **OCLC**, followed by an explanation of the **Dastar** case, a recent opinion by the **US Supreme Court** that has direct relevance for the "**Dewey situation**." Finally, I will return to the trademark claims of **OCLC** and discuss them in light of trademark and copyright law and of the **Dastar** case.

The Library Hotel

In 2000, the luxurious **Library Hotel**™ opened its doors in Manhattan. Located on East 41st Street at the corner of Madison Avenue, the hotel is one block from the **New York Public Library**. According to the hotel Website:

"Most library users know the general structure of **Melvil Dewey's** decimal classification . . . The **Library Hotel** in New York City is the first hotel ever to offer its guest over 6,000 volumes organized throughout the hotel by the **DDC**. Each of the 10 guestrooms floors honors one of the 10 categories of the **DDC** and each of the 60 rooms is uniquely adorned with a collection of books and art exploring a distinctive topic within the category or floor it belongs to."¹

This luxury hotel has received rave reviews since opening. *Conde Nast Traveller*™ rated it one of New York's top 10 hotels.² Visitors to the *Fodors.com*™ Website used phrases such as "Comfortable and Chic!"³ One visitor to the site stated that "Not only were the rooms fabulous, nicely appointed including books in topic with your room name, but the service was second to none. We were able to get everything from the basic, best way to get to X, but also getting a cab on Friday at 5:15 PM, which if you have been to New York you know it can be difficult. They were consistently going above and beyond expectations and were always there to help and make sure our stay was a comfortable one. The hotel is ideally located just a block from Grand Central and just a few blocks from Times Square and the Theater District. The hotel acts as your gateway to New York and never fails to impress.

Should you find yourself looking for a place to stay in New York I highly recommend this hotel as your home away from home."

According to **NORWELD**, the **Northwest Ohio Regional Library System**:

The hotel opened three years ago at Madison Avenue and 41st Street. From its imitation card catalog in the lobby to its stately second-floor reading room, it is designed as a siren for book lovers. Each floor is devoted to one of the 10 main categories of knowledge in the **Dewey system**: Social Sciences, Languages, Math and Science, Technology, the Arts, Literature, History and Geography, General Knowledge, Philosophy and Religion. Hotel guests can request a specific floor or themed room, furnished with the corresponding books. History buffs might consider the ninth floor, with Biography (900.006) or Asian History (900.004). A technology aficionado might give Computers (600.005) a try. The most popular rooms, by far? Erotic Literature (800.001) and Love (1100.006). Room and suite prices on the hotel's Website range from \$295 to \$770 per night.⁴

So why am I writing about the **Library Hotel**? Because **OCLC**, the entity that produces the **Dewey Decimal System**,⁵ has sued the **Library Hotel**™ for trademark infringement. The bibliographic utility is being represented by **Joseph R. Dreidler**, a trademark lawyer with the Columbus office of **Jones Day, Dreidler** has been quoted as saying: "I would term it straight-out trademark infringement. . . A person who came to their Website and looked at the way (the hotel) is promoted and marketed would think they were passing themselves off as connected with the owner of the **Dewey Decimal Classification** system."⁶

An Overview of Trademark Law

So what exactly is a trademark? Let's start with a basic review of the law. Trademarks consist of "Words, names, symbols, or devices used by manufacturers of goods and providers of services to identify their goods and services, and to distinguish their goods and services from goods manufactured and sold by others." The

mark must be "famous" and must be distinctive.⁷ One important requirement of trademark law is that the mark must be used in commerce. If the mark has not been used or has ceased to be used in commerce, it is not capable of being protected. Some examples of trademarks include the following:

Product names such as Kodak for cameras or Burger King for restaurant services.

Slogans such as "Fly the Friendly Skies of United" or "Get a Piece of the Rock."

Characters used to sell products, such as the Pillsbury Dough Boy and Aunt Jemima.

The jingle used by National Public Radio.

The container that a product is delivered in, such as the shape of a Coca-Cola bottle.

Several of these examples actually belong to a subdivision of trademark law known as service marks. The definition of a service mark is "a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others. Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor."⁸

In order to obtain Federal trademark protection, the person or entity must file an application with the US Patent and Trademark Office. Trademark protection is effective for ten years; however it may be renewed for unlimited number of ten-year terms as long as the trademark is still being used. There is also state trademark registration, which varies from state to state. In addition, there is a common law trademark, which continues as long as the trademark is still being used.

Trademark law is contained in section 1111 et. sec. of the US Code, and is based on the Lanham Act. Although we usually don't think about it this way, trademark law is also a type of consumer protection act. After all, the Lanham Act prevents knock-offs from being marketed.

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If there is a chance that the public might be confused or misled as to the origin of a good, the Lanham Act applies. Section 1125 states that:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Section 1125(c)(1) permits remedies for infringement of a "famous mark" in order to prevent dilution. Dilution is the process of others beginning to use the mark so that it is no longer distinctive. Some of the factors that help decide whether a mark is famous and distinctive include:

- a) The degree of inherent or acquired distinctiveness of the mark.
- b) The duration and extent of use of the mark in connection with the goods or services with which the mark is used.
- c) The duration and extent of advertising and publicity of the mark.
- d) The geographical extent of the trading area in which the mark is used.
- e) The channels of trade for the goods or services with which the mark is used;
- f) The degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought.
- g) The nature and extent of use of the same or similar marks by third parties.
- h) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.⁹

Another feature of trademark law is that the mark must not be diluted. "A trademark also represents something that the mark's owner intends to protect: goodwill. Any person who uses a trademark in a way that is likely to cause confusion or dilute the mark's meaning is a potential infringer."¹⁰

The History of the Dewey Decimal System

Now let's return to the **Dewey Decimal System**. The basis of OCLC's claim is that the **Dewey Decimal System** is a trademark, and the

hotel is using the **Dewey Decimal System** in a way that is likely to cause confusion or dilute the meaning. I think a brief history of the **DDC** is now in order.

The **Dewey Decimal System** was created by **Melvil Dewey**. The first edition was published in 1876, and was originally called the "Amherst classification."¹¹ The system was the brainchild of **Dewey**, but he was assisted by many others who worked at Amherst during those years. The system immediately gained popularity among libraries, and became even more widespread with the arrival of the second edition in 1885. This was followed by a number of new editions, each of which refined the system further. The editions are as follows:

- 3rd edition – 1888
- 4th edition – 1891
- 5th edition – 1894
- 6th edition – 1899
- 7th edition – 1911
- 8th edition – 1913
- 9th edition – 1915
- 10th edition – 1919
- 11th edition – 1922
- 12th edition – 1927
- 13th edition – 1932
- 14th edition – 1942
- 15th edition (standard edition) – 1951
- 16th edition – 1958
- 17th edition – 1965
- 18th edition – 1971
- 19th edition – 1982
- 20th edition – 1989
- 21st edition – 1998

In each case, the **Dewey Decimal System** was a copyrighted work. There were a variety of owners over the years, including the **Lake Placid Club Education Foundation**, which **Melvil Dewey** had empowered with the rights. Other entities involved in the creation of **DDC** included the **American Library Association** and the **Library of Congress**. In 1953 the **Library of Congress** assumed responsibility for the editorial policy of **DDC**. **Forest Press**, the publisher, eventually acquired the rights, and was then purchased by **OCLC** in 1988. As a result, **OCLC** now owns the rights to **DDC**.

It is undisputed that more recent editions are protected under copyright law. After all, each new edition is a derivative work which can be protected. However, under copyright law, all works published before December 31, 1922, are in the public domain, and are not protected by copyright. This means that editions 1 through 11 are currently in the public domain under copyright law.

The Trademark Claims by OCLC

The claim by **OCLC** is best stated by **Samuel Trosow**, an Assistant Professor of Information & Media Studies and Law at the **University of Western Ontario**. According to **Trosow**, there are three causes of action:

Federal trademark infringement (alleging that "Defendant's wrongful use of the **Dewey Marks** and misappropriation of the **Dewey Decimal Classification** sys-

tem as a thematic marketing concept for a hotel are likely to cause confusion as to sponsorship or authorization by **OCLC**, or alternatively, destroy the origin-identifying function of the **Dewey Marks**;"

Federal Unfair Competition, False Designation of Origin, Passing Off and False Advertising (alleging that "consumers are deceptively led to believe that The **Library Hotel** originates with or is sponsored or otherwise approved by **OCLC**" and that such conduct "constitute false designation of origin, passing off and false advertising in connection with products and services distributed in interstate commerce;" and

Dilution (alleging that "**OCLC** has no control over the quality of The **Library Hotel's** Website, hotel, advertising and other promotional materials, its use of the **Dewey Marks**, and its misappropriation of the **Dewey Decimal Classification** system as a thematic marketing concept for a hotel. As a result of such use by The **Library Hotel**, the distinctive qualities of the **Dewey Marks** are being and will continue to be diluted" and that "**OCLC** is suffering and will continue to suffer irreparable harm and blurring of the **Dewey Marks** if Defendant's wrongful conduct is allowed to continue.")¹²

As an expert on intellectual property and on libraries, **Trosow** was not convinced by the claims:

I have to say that I find this complaint disturbing. Maybe it's none of my business, just a dispute between a non-profit association loosely somewhat affiliated with libraries and a profit making hotel. But on the other hand, and even though **OCLC** is an independent group, I'm concerned that the public will tie this action in with the broader public library community. After all, public library users have long associated the **Dewey Decimal System** with their experiences in public libraries. It's news to many that there are proprietary restrictions on the system (have you ever seen a TM notice in a public library alongside the call numbers?) so I think the enforcement of these rights has to be handled extremely delicately. The idea of seeking the broad punitive remedies requested in the complaint may seem harsh to some. I'm concerned that this incident could damage some of the goodwill the library community has carefully built up in the public policy arena with respect to our efforts to hold back the tide of intellectual property expansions. I think that most members of the public associate the **Dewey Decimal System** with the public goods nature of public library services and would find these requests somewhat unreasonable. The legal theories themselves give the public very little credit for being able to distinguish the **DDC** itself from a novelty item in a hotel. Let's

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give people a little bit of credit, I doubt very much that many people are going to be confused by this rather peripheral usage. We need to be concerned that the image of public libraries will be tarred by this action. In particular, we need to be concerned that the efforts of all of the library associations to limit the expansionary proprietary reach of intellectual property laws will seem rather two-faced and self-serving, and that, as a result, this incident could erode some of the goodwill we have built up. I have to wonder out loud whether OCLC is acting in the best interests of the broader public library community, and whether there may be a less drastic way of settling this dispute.¹³

Several commentators believe that OCLC is trying to use trademark law to enforce an expired copyright. According to **Christine Haight Farley**, associate professor of law and associate director of the Glushko-Samuels Intellectual Property Law Clinic at **American University Washington College of Law**, "Although it is surprising that the **Dewey Decimal System** is not in the public domain and available for public use, the fact that someone may have proprietary rights to it is not the end of the inquiry. To prove trademark infringement, the trademark owner will have to prove that consumers would likely be confused into thinking the hotel is connected with the previously unknown owner of the **Dewey Decimal System**."¹⁴

Eugene Volokh, a professor at **UCLA School of Law**, stated that "It seems to me that people who look at the **Library Hotel's** site wouldn't remotely think that the hotel was connected with the owner of the **Dewey** system (at least unless the site has changed considerably since the suit was filed). Most people don't even know the **Dewey** system is owned; those who do know this probably won't give it a second thought, because they'll see the hotel as referring to the system, not claiming an endorsement from or connection with the owner of the system."¹⁵

This issue has also been making the rounds of Internet newsgroups and email discussion lists. One post stated that "I can certainly see the difference between the **Dewey Decimal system**, used in libraries, and the hotel, with pictures of lovely beds and bedding on their website. That I know of, no actual library is offering me expensive sheets and towels to read their books."¹⁶

The Dastar Case: The Relationship Between Trademark and Copyright

One of the biggest problems with OCLC's trademark claim is that the **Dewey Decimal System** was not trademarked from the beginning, it was copyrighted, which precludes trademark protection for the early editions. Although more recent editions have indeed been trademarked, the older ones have long since passed into the public domain. In addition, the likelihood of confusion (a primary requirement for a trademark lawsuit) is nonexistent. I don't be-

lieve that OCLC has any intellectual property interest in the name **Dewey Decimal System** at all, due to the nature of the older editions. As one commentator stated:

What a ridiculous suit. The **Dewey Decimal System** was created in 1873, which means as far as copyright law is concerned, even if it's "original" enough to have copyright, it's most likely in the public domain . . . OCLC is, of course, bringing a trademark claim because of this problem, but it will be interesting to see how they get around the **Dastar** problem, where trademark cannot be used to protect copyrighted works that have fallen into the public domain. Not to mention the fact that **Dewey Decimal** is almost certainly generic — I mean really, who thinks of it as a product associated with a particular vendor, let alone a "product" in the first place?¹⁷

This message is referring to the case of **Dastar Corporation v. 20th Century Fox Film Corporation**, 539 US ____ (2003).¹⁸ This case, argued April 2, 2003, was decided 8-0 by the US Supreme Court on June 2, 2003. (Justice **Breyer** did not take part in the consideration of the case.) Justice **Scalia** wrote the opinion of the Court. This case involves a trademark claim for some copyrighted materials that had passed into the public domain, making it directly relevant to the OCLC-Library Hotel dispute.

The **Dastar** case involves **General Dwight D. Eisenhower's** work *Crusade in Europe*. This was his written account of the European campaign during World War II. After **Doubleday** published the book, exclusive television rights were granted to **Twentieth Century Fox**, which in turn licensed **Time Inc.** to produce a television series. The series had 26 episodes, and was first broadcast in 1949. Although **Doubleday** renewed the copyright on the book in 1975, **Fox** did not renew the copyright on the TV series, which expired in 1977.¹⁹

In 1988, **Doubleday** granted **Fox** exclusive rights again in the book, which it granted to **New Line Home Video**. The original television series was re-mastered and released on home video. What happened next is best quoted from the Opinion of the Court:

Enter petitioner **Dastar**. In 1995, **Dastar** decided to expand its product line from music compact discs to videos. Anticipating renewed interest in World War II on the 50th anniversary of the war's end, **Dastar** released a video set entitled *World War II Campaigns in Europe*. To make *Campaigns*, **Dastar** purchased eight beta cam tapes of the original version of the **Crusade** television series, which is in the public domain, copied them, and then edited the series. **Dastar's Campaigns** series is slightly more than half as long as the original **Crusade** television series. **Dastar** substituted a new opening sequence, credit page, and final closing for those of the **Crusade** television series; inserted new chapter-title sequences and narrated chapter introductions; moved the "recap" in the **Crusade** television series to the beginning and retitled it as a "preview," and removed references to and images of the book. **Dastar** created new packaging for its *Campaigns* series and (as al-

ready noted) a new title . . . **Dastar** manufactured and sold the *Campaigns* video set as its own product.

The District Court and the 9th Circuit Court of Appeals held for **Fox** on trademark and unfair competition grounds under § 43(a) of the Lanham Act, 15 U.S.C. 1125(a). The issue in the lower courts was "Reverse Passing Off." According to the opinion: "Passing off (or palming off, as it is sometimes called) occurs when a producer misrepresents his own goods or services as someone else's. See, e.g., *O. & W. Thum Co. v. Dickinson*, 245 F. 609, 621 (CA6 1917). Reverse passing off, as its name implies, is the opposite: The producer misrepresents someone else's goods or services as his own. See, e.g., *Williams v. Curtis-Wright Corp.*, 691 F.2d 168, 172 (CA3 1982)."²⁰ We all know that selling a cheap watch and calling it a Rolex is misrepresentation, but so is a restaurant serving **Coke** and calling it **Pepsi**, both because they are not really selling **Coke**, and because they are claiming **Coke's** product as being from **Pepsi**. (This is why restaurants now ask you if **Pepsi** is ok if you order a **Coke**.)

Basically, the District Court and the 9th Circuit ruled that **Dastar** had passed off the work of **Fox** as its own. The District Court also held for **Fox** on copyright grounds, but the 9th Circuit reversed that portion of the claim.²¹ According to the Court of Appeals, "**Dastar** copied substantially the entire *Crusade in Europe* series created by **Twentieth Century Fox**, labeled the resulting product with a different name and marketed it without attribution to **Fox** [and] therefore committed a bodily appropriation of **Fox's** series. . . [concluding that] **Dastar's** bodily appropriation of **Fox's** original [television] series is sufficient to establish the reverse passing off."²² The court found that the misrepresentation created a risk of confusion in the minds of the consumer, which is one of the basic requirements of a suit for trademark infringement, stating that "in marketing and selling *Campaigns* as its own product without acknowledging its nearly wholesale reliance on the **Crusade** television series, **Dastar** has made a 'false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . as to the origin . . . of his or her goods.'"²³

The US Supreme Court, on the other hand, was not convinced by this argument and found for **Dastar**. According to the Supreme Court:

The problem with this argument according special treatment to communicative products is that it causes the **Lanham Act** to conflict with the law of copyright, which addresses that subject specifically. The right to copy, and to copy without attribution, once a copyright has expired, like "the right to make [an article whose patent has expired]-including the right to make it in precisely the shape it carried when patented-passes to the public." *Sears, Roebuck & Co. v. Stiffel Co.*, 376 US 225, 230 (1964); see also *Kellogg Co. v. National Biscuit Co.*, 305 US 111, 121.122 (1938). "In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying." *TrafFix Devices, Inc. v. Marketing Displays, Inc.*,

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532 US 23, 29 (2001). The rights of a patentee or copyright holder are part of a "carefully crafted bargain," *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 US 141, 150-151 (1989), under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution. Thus, in construing the **Lanham Act**, we have been "careful to caution against misuse or over-extension" of trademark and related protections into areas traditionally occupied by patent or copyright. *Truffix*, 532 US, at 29. "The **Lanham Act** . . . does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity." *Id.*, at 34. Federal trademark law "has no necessary relation to invention or discovery," *Trade-Mark Cases*, 100 US 82, 94 (1879), but rather, by preventing competitors from copying "a source-identifying mark," "reduce[s] the customer's costs of shopping and making purchasing decisions," and "helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product," *Qualitex Co. v. Jacobson Products Co.*, 514 US 159, 163-164 (1995) (internal quotation marks and citation omitted). Assuming for the sake of argument that *Dastar's* representation of itself as the "Producer" of its

videos amounted to a representation that it originated the creative work conveyed by the videos, allowing a cause of action under §43(a) [of the **Lanham Act**] for that representation would create a species of mutant copyright law that limits the public's "federal right to 'copy and to use,'" expired copyrights, *Bonito Boats, supra*, at 165. . . .

The *Dastar* case is directly applicable to the **OCLC-Library Hotel** dispute in several ways. First of all, there is a question about the "origin of goods" that the *Dastar* case considered. Secondly, this claim is being used on a formerly copyrighted item that has passed into the public domain. **OCLC** is claiming that it is the originator of the goods. Yet the *Dastar* case clearly stated that the **Lanham Act** could not be used to get around an expired copyright:

In sum, reading the phrase "origin of goods" in the **Lanham Act** in accordance with the Act's common-law foundations (which were not designed to protect originality or creativity), and in light of the copyright and patent laws (which were), we conclude that the phrase refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods. Cf. 17 U. S. C. §202 (distinguishing between a copyrighted work and "any material object in which the work is embodied.") To hold otherwise would be akin to finding that §43(a) (of the **Lanham Act**) created a species of perpetual patent and copyright, which Congress

may not do. See *Eldred v. Ashcroft*, 537 US 186, 208 (2003).

There are several other problems with **OCLC's** trademark claim. One problem, also discussed in the *Dastar* case, involves the way in which the **Lanham Act** could be used against a party either way. "On the one hand, they would face **Lanham Act** liability for failing to credit the creator of a work on which their lawful copies are based; and on the other hand they could face **Lanham Act** liability for crediting the creator if that should be regarded as implying the creator's 'sponsorship or approval' of the copy. . . ."

Another problem with **OCLC's** claim involves the lack of trademark designation and enforcement in the library world. Law Librarian **Rick Anderson** pointed out that many schools, including the **University of Illinois**, use the **Dewey Decimal System** without the TM designation.²⁴ In fact, another **Samuel Trosow** pointed out that **OCLC** itself has many pages that do not use the TM designation, including the following:

<http://www.oclc.org/dewey/>
<http://www.oclc.org/dewey/about/default.htm>
<http://www.oclc.org/support/documentation/dewey/>
<http://www.oclc.org/dewey/versions/ddc22print/>

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Endnotes

1. The Library Hotel™, *The Library Concept*, available at <http://www.libraryhotel.com/concept.htm> (last visited October 8, 2003).
2. Conde Nast Traveller™, *Top Ten Manhattan Hotels: The Library Hotel*, available at http://www.cntraveller.co.uk/topten/info/Manhattan_Hotels/Library_Hotel/default.html (Last visited October 8, 2003).
3. Fodors.com, *Rants & Raves: Rate Library Hotel*, available at http://fodors.com/rants/rrread.cfm?destination=new_york_city@111&class=Hotels@20003&entity_id=54060&property=LIBRARY%20HOTEL@267956&sort=name&pg=4 (Last visited October 8, 2003).
4. Michael Luo, *Where did Dewey file those law books?* New York Times, September 23, 2002, Late Edition-Final, Metropolitan Desk, p. B1; available at <http://www.norweld.lib.oh.us/norweldnews/viewer.asp?ID=2284> (last visited October 8, 2003).
5. I am purposely not using a ® or TM symbol here because I do not believe that the trademark claim is valid.
6. Mike Pramik, *Trademark Lawsuit: Hotel's use of library theme opens legal chapter*, Columbus (Ohio) Dispatch, September 20, 2003, Home Final Edition, p. 01A.
7. Findlaw for Legal Professionals, *Patent, Trademark, and Trade Secret Law: Trademark Law*, Available at http://profs.lp.findlaw.com/patents/patents_2.html (last visited October 8, 2003).
8. Walter E. Hurst and Fred Woessner, *How to Register a Trademark: Protect Yourself Before You Lose Your Priceless Trademark*, p.2 (Hollywood, CA: Seven Arts Press, 1983).
9. 15 U.S.C. §1125(c)(1). Available at <http://www4.law.cornell.edu/uscode/15/1125.html> (last visited October 8, 2003).
10. Rodger Braunfeld and Thomas O. Wells, *Intellectual Property Protection*, available at http://informatica.uv.es/iiguia/2000/IPI/material/intellectual_prop.pdf (last visited October 8, 2003).
11. John Phillip Comaromi, *The 18 Editions of the Dewey Decimal System*, p. 31 (Albany, NY: Forest Press Division, Lake Placid Foundation, 1976).
12. Samuel Trosow <strosow@uwo.ca>, *OCLC Complaint*, posting to law-lib-l@ucdavis.edu, September 24, 2003. Available at <http://lawlibrary.ucdavis.edu/LAWLIB/Sept03/0413.html> (last visited October 8, 2003). Trosow is quoting Quoting <http://www.bespacific.com/mt/resources/2003.09.22.hotel.pdf>.
13. *id.*
14. Kathy Thompson, *Dewey Decimal System Trademark Holder Sues Hotel for Using System as Decorating Theme—AU Trademark Law Expert Can Discuss*, AU News (American University), available at <http://domino.american.edu/AU/media/mediaref.nsf/0/c31699ee5bddf79e85256dac00703a92?OpenDocument> (Last visited October 8, 2003).
15. Eugene Volokh, *Dewey Decimal System vs. Hotel*, The Volokh Conspiracy, Available Online at http://volokh.com/2003_09_21_volokh_archive.html#106417224379671292 (last visited October 8, 2003).
16. Mary Hodder, *Love May Fade But Trademark is Forever*, posted on the Berkeley Intellectual Property Weblog, September 22, 2003. Available at <http://journalism.berkeley.edu/projects/biplog/archive/001102.html> (Last visited October 8, 2003).
17. Jason Schultz, *OCLC Sues Hotel Over Dewey Decimal System*, October 1, 2003. Available at <http://lawgeek.blogspot.com/> (Last visited October 8, 2003).
18. Dastar Corporation v. 20th Century Fox Film Corporation, 539 U.S. ____ (2003). Available at http://www.acm.org/usacm/PDF/Legal/Dastar_v_Twentieth_Century.pdf (Last visited October 7, 2003).
19. This information is taken directly from the Opinion of the Dastar Court.
20. Dastar at note 1.
21. 34 Fed. Appx. 312, 316 (2002).
22. 34 Fed. Appx. 312, 314. This language from the 9th Circuit was also quoted in the Supreme Court opinion.
23. This language comes from the Supreme Court decision, which is quoting the 9th Circuit opinion. The Supreme Court also referenced the Brief for Respondents 8, 11.
24. The page that Anderson is referencing is found at <http://www.uic.edu/depts/lib/reference/resources/uiccat/>. Rick Anderson <rickand@unr.edu>, *Dewey, The Library Hotel and U. Illinois*, posted to liblicense-l@lists.yale.edu, September 26, 2003. Available at <http://www.library.yale.edu/~llicense/ListArchives/0308/msg00277.html> (Last visited October 8, 2003).
25. Samuel Trosow <strosow@uwo.ca>, *Re: Dewey, The Library Hotel and U. Illinois*, posted to liblicense-l@lists.yale.edu, 27 Sep 2003. Available at <http://www.library.yale.edu/~llicense/ListArchives/0308/msg00277.html> (Last visited October 8, 2003).


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<http://www.oclc.org/dewey/versions/webdewey/>

<http://www.oclc.org/dewey/versions/abridgededition14/25>

Finally, OCLC has not gone after libraries that have used Dewey numbers without purchasing their DDC products. The selective nature of OCLC's enforcement is going to hurt their case considerably. On the other hand, if this lawsuit were successful, any library that did not join OCLC or a regional bibliographic utility or that did not purchase the DDC would not be able to use Dewey as their system. OCLC will have a difficult time in the courts with the idea of selective enforcement, and an even more difficult time in the profession with the idea of library enforcement.

Conclusion

OCLC's claim against the Library Hotel is based on trademarks in recent editions of the DDC. Yet the older issues were copyrighted rather than trademarked, and are currently in the public domain. The Dastar case speaks directly to this issue, stating that you can't use trademark enforcement to get around an expired copyright. OCLC also has difficulties in that it has not enforced the alleged trademark in the past, and is using selective enforcement in the present. Only time will tell whether OCLC will prevail; however, it is this author's belief that their case doesn't have a leg to stand on. Only time will tell. In the meantime, I'm thinking of making reservations at the Library Hotel for my next trip to New York. Even if they have to change their theme, it still sounds like a nice place to stay. And what more could you ask for in the greatest city in the world! 

Questions & Answers — Copyright Column

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QUESTION: *A library in a for-profit company owns issues of a journal title published prior to 1923 and wants to scan articles from these issues. May it do so without being concerned about copyright?*

ANSWER: Yes, if the journals were published in the United States before 1923, they are in the public domain. This means that anyone may reproduce the articles, even for public consumption. Thus, copying of these journals for the company library presents no copyright problem.

QUESTION: *How are international publications covered under US law? Are they protected?*

ANSWER: The first determination is what is meant by "international publications?" Are these publications by international organizations such as the United Nations or are they works published in a foreign country? If the work is published by the United Nations, any of its agencies or the Organization of American States, it is subject to protection under US copyright law according to section 104(b)(5) of the Copyright Act. Works by other international organizations are not subject to US copyright.

Foreign works are protected under US copyright if they are published in a country that is the party to a copyright treaty to which the United States is a signatory. See section 104(b)(2). This would include all of the signatory countries to the Berne Convention or any bilateral or multilateral treaty to which the United States is a party. Additionally, under section 104(b)(6), the President may by proclamation extend US copyright to works published in another country if that nation extends copyright to US authors on virtually the same basis as it extends to its own authors.

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